

REMARKS

Drawings

The Examiner objected to the drawings under 37CFR 1.83(a), because the drawings did not show a “portable medium.”

In response, applicants submit an additional drawing sheet including FIG. 5 for the Examiner’s approval. FIG. 5 is an additional drawing illustrating a storage medium 500 that includes consumption history 510.

Applicants submit that FIG. 5 contains no new matter and is fully supported by the specification as filed. For example at page 13, lines 19-21, the specification discloses that “the history [510] of the consumption type or consumption behavior is recorded in a movable storage medium [500] such as a smart card [(FIG. 5)].”

Upon the Examiner’s approval, applicants will amend the specification, including the Brief Description of the Drawings, with the proper references to FIG. 5.

Claims

Claims 15-24 and 30-33 were pending when last examined. With this Response, Applicants have amended claims 19 and 23. No new matter has been added.

Claim Objections

Claims 19 and 23 were objected to because of informalities.

Claims 19 and 23 have been amended to address the Examiner’s objection.

Claim Rejections – 35 USC § 103

Claims 15-18, 20, 22, and 30 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,778,182 to Cathey et al. (“Cathey”) in view of the “CineMage” reference. Applicants respectfully traverse the rejections.

Claim 15 recites a method for processing user history data. The method includes recording a user action item corresponding to consumption of multimedia content having a content reference identifier, assigning a program identifier and a user action type to the user action item, and specifying whether information in the user action item is protected.

As admitted by the Examiner and discussed in Applicant's Response of February 23, 2006, Cathey fails to disclose specifying whether information in a user action item is protected, as required by the claim. The Examiner points to the "CineMage" reference for the missing subject matter. CineMage, however, is also lacking.

In particular, the Examiner points to a section entitled "Content Protection through Content ID":

NTT is very interested in the protection of digital content. This is, of course, also an issue for ACT and indeed for anyone selling digital content on the internet. NTT is part of a group called the Content ID Forum, which is developing what they hope will be a standard for the protection of digital content. The concept is that of a digital code called a Content ID, which would be embedded in each digital file using watermarking or other similar techniques. Because the ID is embedded in the file, it is possible to track the use of the file and prevent unauthorized use.

ACT currently uses several methods to protect our images. These include embedding a visible watermark into images ...

CineMage in paragraph #9. In short, CineMage discloses protecting digital content, such as images, by embedding a Content ID into the file that includes the digital content.

Although the claim recites multimedia content having a content reference identifier, the claim does not require CineMage's protection of the content. CineMage protects digital content, such as images, sold on the Internet. Instead of protecting digital content, the claim recites specifying whether information in a user action item is protected. The claim also recites recording the user action item corresponding to consumption of the multimedia content. Such a user action item is very different from the digital content protected in CineMage. Accordingly, CineMage fails to disclose or suggest protecting information in the claimed user action item. Lacking any disclosure about protecting information in the user action item, CineMage cannot disclose or suggest the step of specifying whether information in the user action item is protected, as required by the claim.

Furthermore, the Examiner states that "it would have been obvious for one of

ordinary skill in the art to add the watermark, taught by CineMage, to the files disclosed by Cathey ... to enable the tracking of the files, and therefore prevent unauthorized use.” The Examiner, however, is silent about which “files disclosed by Cathey” should the artisan “add the watermark” to. Applicants assume that the Examiner was referring to Cathey’s available applications or event records. *See, e.g.,* Abstract.

First, if the watermark of CineMage is added to the files of the available applications of Cathey, the combination would clearly lack specifying whether information in the user action item is protected. Indeed, nowhere does Cathey disclose or suggest that any available application, by itself, is a user action item corresponding to consumption of multimedia content.

Second, if the watermark of CineMage is added to the event records of Cathey, the combination would still lack the step of specifying whether information in the user action item is protected. Furthermore, adding watermarks to the event records to track those event records is clearly not suggested by any of the references. Indeed, Cathey’s event records are already used to track usage of other objects, such as the available applications. *See, e.g.,* Abstract. Thus, watermarking the event records would serve for tracking usage of files (the event records) that themselves are used for tracking yet another files (the available applications). Neither CineMage nor Cathey discloses or suggests such a convoluted scenario.

Because the combination of Cathey and CineMage fails to disclose or suggest specifying whether information in the user action item is protected, no *prima facie* case of obviousness has been established and claim 15 should be allowed. Claims 16-18, 20 and 30 depend from claim 15, and are allowable for at least the same reasons.

Claim 22 recites a method that includes assigning protection information to the recorded user action item, the protection information specifying whether information in the user action item is protected. As discussed above with reference to claim 15, both Cathey and CineMage fails to disclose or suggest this limitation. Thus, no *prima facie* case of obviousness has been established and claim 22 should be allowed.

Claims 19 and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cathey in view of CineMage as applied to claims 18 and 22 above, and further in view of U.S. Pat. No. 6,349,410 to Lortz (“Lortz”).

Claim 19 depends from claim 15, which recites specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Lortz is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 19 should be allowed.

Claim 23 depends from claim 22, which recites assigning protection information to the recorded user action item, the protection information specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Lortz is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 23 should be allowed.

Claims 21 and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cathey in view of CineMage, and further in view of U.S. Pat. No. 5,717,859 to Yunoki (“Yunoki”). Applicants respectfully traverse the rejections.

Claim 21 depends from claim 15, which recites specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Yunoki is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 21 should be allowed.

Claim 24 depends from claim 22, which recites assigning protection information to the recorded user action item, the protection information specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Yunoki is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 24 should be allowed.

Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cathey in view of CineMage as applied to claim 30 above, and further in view of JP 10320413 (“Kutsumi”). Applicants respectfully traverse the rejections.

Claim 31 depends from claim 15, which recites specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Kutsumi is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 31 should be allowed.

Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cathey in view of CineMage as applied to claim 30 above, and further in view of U.S. Pat. No. 6,745,367 to Bates et al. (“Bates”). Applicants respectfully traverse the rejections.

Claim 32 depends from claim 15, which recites specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Bates is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 32 should be allowed.

Claim 33 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cathey in view of CineMage as applied to claim 30 above, and further in view of U.S. Pat. No. 6,727,914 to Gutta (“Gutta”). Applicants respectfully traverse the rejections.

Claim 33 depends from claim 15, which recites specifying whether information in the user action item is protected. As discussed above, neither Cathey nor CineMage discloses or suggests this limitation. Gutta is equally lacking. Thus, no *prima facie* case of obviousness has been established and claim 33 should be allowed.

CONCLUSION

Applicants respectfully request that the pending claims be allowed and the case passed to issue. Should the Examiner wish to discuss the Application, it is requested that the Examiner contact the undersigned at (415) 772-7493.

No additional fees are required for this amendment. However, the Commissioner is hereby authorized to charge any additional fees, which may be required, or credit any overpayment to Deposit Account No. 50-1597.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

6/7/06

Date

Richard A. Paele

Signature

Respectfully submitted,

By:

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FP/lcd

June 7, 2006

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